

REMARKS

The Office Action of March 9, 2010 has been carefully considered. Reconsideration of this application is respectfully requested in view of the arguments presented herein.

Office Action is Defective

Applicants respectfully submit that the instant office action is defective on its face as it sets forth a rejection that is the same as that set forth in the office action of December 2008. Applicants responded to the rejection of claims 1-13, 15 and 17-19 (which include currently restricted claims 1-5) in the response submitted on March 26, 2009. The Examiner has not acknowledged or responded to Applicants prior arguments in the current Office Action and it is, therefore, defective. Given the significant pendency of this matter Applicants, once again, respectfully request that the Examiner refrain from further piecemeal examination and provide a complete and thorough response to all arguments presented herein. See MPEP §707.07(f)-(g).

Summary of Office Action

Turning now, to the office action, the Examiner has made the prior restriction requirement final and has now limited the examination to claim 1 - 5.¹ Claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Herron (US 2005/0157921 A1) in view of Tagami et al. (US 5,237,425; "Tagami").

Arguments in Traversal of Rejection

In response to the rejection, Applicants submit herewith the following arguments in traversal of the rejection as applied to claims 1 – 5:

Claims 1-5 were rejected under 35 USC §103(a) as being obvious in view of Herron and Tagami. Considering, first, independent claim 1, Applicants respectfully submit that the rejection fails to set forth a *prima facie* case of obviousness. First, the Examiner fails to properly support the alleged basis for the combination.

¹ Applicants continue to urge that the requirement for restriction is improper, and await a decision on the petition submitted July 3, 2010 in this regard. Pending a decision on said petition, Applicants respectfully reserve the right to challenge the continued assertion of the restriction and the Examiner's refusal to examine all pending claims 1 – 19.

Considering the basis set forth to support the alleged combination (see p. 6 of current office action), at best the basis is a regurgitation of Applicants' claim language, rather than an independent assessment of what one of skill in the art would have been motivated to do. Moreover, the statement improperly relies on Applicants' claim language and as such can only demonstrate that the Examiner continues to engage in hindsight reconstruction. Withdrawal of the rejection is respectfully requested.

Second, even if considered *in arguendo*, the combination of Herron and Tagami fails to set forth all the limitations recited in claim 1 as previously acknowledged by the Examiner.

In setting forth the rejection of claim 1, the Examiner relies upon alleged teachings of Tagami. In particular, the Examiner again alleges that Tagami teaches determining a rendering characteristic, as set forth as the third and fourth elements of claim 1. Applicants respectfully disagree and urge that this position by the Examiner is contrary to that previously asserted by the Examiner. In particular, in the Office Action dated June 24, 2008, at page 3, the Examiner stated,

Tagami'425 fails to show a method determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space.

Accordingly, on its face, the current rejection again fails to establish *prima facie* obviousness as the Examiner has acknowledged that Herron (Current Action, p. 5) and Tagami (June '08 Action, p. 3) both fail to teach that limitation. Whether considered alone or in combination, the Examiner has previously admitted on the record that the patents presented as the basis for the rejection fail to teach all of the limitations set forth in independent claim 1. Hence the rejection

is traversed, and claim 1 is respectfully urged to be in condition for allowance. Withdrawal and immediate indication of allowance, in view of this fifth non-final rejection, is respectfully requested. In the event the rejection is somehow maintained, Applicants respectfully request that the Examiner identify on the record why an alternative and contradictory interpretation of Tagami is now applicable and then permit Applicants to respond accordingly.

As for dependent claims 2-5, these claims all depend from now presumably allowable claim 1 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to the independent claim. For purposes of brevity specific arguments of patentability are not presented herein but are respectfully reserved for a subsequent response or on appeal. In view of Applicants response above, and a similar response submitted in March 2009, Applicants respectfully request that the Examiner provide a complete reply that addresses ALL arguments presented by Applicants.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 24-0037 for Xerox Corporation.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

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